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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,990	10/13/1999	CHRISTOPHER J. LOVETT	MSI-383US	8254

22801 7590 10/20/2003

LEE & HAYES PLLC  
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SPOKANE, WA 99201

EXAMINER
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QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2178

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DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/417,990

Applicant(s)

LOVETT ET AL.

Examiner

Adam M Queler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 14-17 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 14-17 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to communications: Amendment B filed 7/28/2003
2. Claims 1-4, 14-17, and 22 are pending in the case. Claims 1, 14, and 17 are independent claims.
3. Claims 1-4, 14-17, and 22 remain rejected in view of the previously cited art.

#### *Claim Rejections - 35 USC § 103*

4. **Claims 1, 2, 4, 14, 16, 17 and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over XML Authority™ by Extensibility Inc, hereinafter Authority, and further in view Applicants Admitted Prior Art.**

**Regarding independent claim 1**, Authority discloses converting between schema formats (p. 1). Authority teaches, “XML Authority imports schema information residing in existing data structures and documents (p. 3).” Also, “XML Authority outputs ... DTD’s (p. 3). Authority does not explicitly disclose validation and tree construction. Inherently, All XML documents must be parsed in order to be processed. It would have been obvious to one of ordinary skill in the art at the time of the invention to parse into schema element and data element because they are physically separate within the document, and because they are logically different components that serve different functions. Applicant admits that DTDs were used to validate data elements (p. 6, ll. 17-21). Applicant also admits that, in prior art systems, upon validation a data tree was constructed (p. 6, 13-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Applicant’s Admitted Prior Art with Authority to enable output to many types of standards (Authority, p. 3, “Diverse...”).

**Regarding dependent claim 4**, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

**Regarding independent claim 14**, the architecture for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 16**, the computer readable medium for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 17**, the client/server for performing the method of claim 14 is rejected under the same rationale.

**Regarding independent claim 22**, the system for performing the method of claim 1 is rejected under the same rationale.

**Regarding dependent claim 2**, Authority discloses converting from schema to DTD (p. 1). Inherent in converting is constructing the DTD objects. Official Notice is taken the calling a method in an API was a well-known method of executing a computer task. It would have been obvious to one of ordinary skill in the art at the time of the invention to call an API method to construct the DTD to provide an interface for programmers.

**5. Claims 3 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Authority and Applicant's Admitted Prior Art as applied to claims 1 and 14 above, and further in view of Hickman et al. (USPN 6564252—filed 3/11/1999).**

**Regarding dependent claims 3 and 15**, Authority is silent as to tables. Hickman et al. (Hickman) discloses tables of schemas (col. 8, ll. 65-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hickman, Authority and Applicant's Admitted Prior Art in order to provide a place to store the schemas.

***Response to Arguments***

6. Applicant's arguments filed 7/28/2003 have been fully considered but they are not persuasive.

**Regarding Applicant's remarks on pp. 6-7, regarding claim 1:**

Applicant alleges that Authority teaches only converting DTD's to schemas, rather than Schemas to DTD's. The Office disagrees. While page 1 does disclose "*e.g.* DTD to XML Schema," the Office cited portion also discloses the fact the XML Authority could "convert from one schema format to another." The document when taken as a whole does in fact teach converting from schemas to DTDs. Authority teaches, "XML Authority imports schema information residing in existing data structures and documents (p. 3)." Also, "XML Authority outputs ... DTD's (p. 3). These two passages clearly teach converting XML schemas into DTD's.

**Regarding Applicant's remarks on pp. 7-8 regarding claim 1:**

Applicant alleges that the Office as utilized hindsight analysis, but has provided no specifics as to what parts of the rejecting have been improperly ascertained. The Office has addressed the argument the Authority does not teach converting schema into DTD, above. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "improv[ing] the architecture of the node factory design") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The admissions that the Office has used in the rejection, relate to the discussion of FIG. 2, labeled as "PRIOR ART." As the motivation for combination was garnered from Authority, the Office sees no basis for the allegation of hindsight reasoning.

In light of the previous remarks, the Office disagrees with Applicant's allegation that a *prima facie* case obviousness as not been established, and maintains the previous rejections.

7. As Applicant as only relied on the deficiencies of the rejection of claim 1 to traverse the remainder of the rejections, and those deficiencies have been addressed above, claims 2-4, 15-17, and 22 remain rejected as well.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

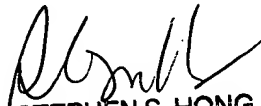
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5631.

AQ

  
STEPHEN S. HONG  
PRIMARY EXAMINER